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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,932	01/20/2000	Richard Alan Fiedotin	10160-02-999	3747
24341 7590 08/23/2007 MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306			EXAMINER COBANOGLU, DILEK B	
			ART UNIT 3626	PAPER NUMBER
			MAIL DATE 08/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/487,932	FIEDOTIN ET AL.	
	Examiner	Art Unit	
	Dilek B. Cobanoglu	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-66,89 and 90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-66,89 and 90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/11/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Request for Continued Examination (RCE) received on 05/07/2007. Claims 45-66 and 89-90 remain pending in this application.

Claim Objections

2. Claim 45 is objected to because of the following informalities: Claim 45 recites "receiving, at the server, a **synchronization signal** from a respective handheld computing device operated by a respective one of said identified physicians; and in response to said **communication signal**, automatically transmitting said interactive message from the computer system to said respective handheld computing device." Examiner considers that Applicant meant to state synchronization signal instead of communication signal in the second part.

3. Appropriate correction is required.

Specification

4. The amendment filed 05/07/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 45 recites "identifying at least two physicians from a database of multiple physicians". In particular,

Applicant points to page 20 of the specification, it states "another embodiment of the present invention comprises an interactive messaging system which provides physicians with timely and relevant information that is customized specifically for an individual physician or group of physicians". Examiner did not able to find "identifying at least two physicians from a database" within the specification as originally filed. As such, Applicant respectfully requested to clarify the above issues and to specifically point out support for the newly added limitation in the originally filed specification and claims.

5. The specification is objected to under 35 U.S.C. 112, first paragraph, because the specification, as originally filed, does not provide support for the invention as is now claimed for the reasons given in section 2 above.
6. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 45-66 and 89-90 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

Art Unit: 3626

was filed, had possession of the claimed invention and for the reasons set forth in the objection to the specification above.

9. Independent claim 45 recites limitation that is new matter, as discussed above.

10. Claims 46-66 and 89-90 incorporate the deficiencies of independent claim 45, through dependency, and are also rejected.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in 05/07/2007 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 2-4 above in the next communication sent in response to the present Office action.

12. Claims 45-66 and 89-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falchuk et al, (hereinafter Falchuk) (U.S. Patent No. 6,256,613), Wharton et al. (hereinafter Wharton) (U.S. Patent No. 5,831,664) and further in view of Examiner's official notice.

Art Unit: 3626

A. Claim 45 is amended now to recite a method for distributing medical information stored on a computer system to physicians (Falchuk; abstract, col. 2, lines 11-21), the method comprising:

- i. At a server in said computer system: identifying at least two physicians from a database of multiple physicians;
- ii. Generating an interactive message comprising: customizing at least a portion of said medical information stored on the computer system to said identified physicians (Falchuk; col. 5, lines 35-47, col. 6, lines 11-17);
and
- iii. Including objects that the physicians can select to respond to, or dispose of, the interactive message;
- iv. Receiving, at a server, a synchronization signal from a respective handheld computing device operated by a respective one of said identified physicians; and
- v. In response to said communication signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device.

- Falchuk fails to expressly teach at a server identifying at least two users from a database of multiple users, per se, since Falchuk teaches identifying a physician (Falchuk; col. 2, lines 11-21).
However, this feature is well known in the art, as evidenced by Wharton.

In particular, Wharton discloses at a server identifying at least two users from a database of multiple users (Wharton; abstract, col. 2, lines 11-35).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Wharton with the motivation of allowing multiple mobile interface devices to interact with an interactive terminal (Wharton; col. 2, lines 8-10).

- Falchuk fails to expressly teach receiving, at a server, a synchronization signal from a respective handheld computing device. However, this feature is well known in the art, as evidenced by Wharton.

In particular, Wharton discloses receiving, at a server, a synchronization signal from a respective handheld computing device (Wharton; abstract, col. 2, lines 11-35).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Wharton with the motivation of synchronizing display of data relating to a predetermined application between an interactive terminal and at least one mobile interface device having a display (Wharton; abstract).

- Falchuk does not explicitly disclose the physicians can select to respond to, or dispose of, the interactive message. However, the Examiner takes official notice that it was well known in the electronic messaging/computing arts to select to respond or dispose/delete an incoming message. The motivation would have been to obtain the information that is needed by the physician, and therefore not wasting time with the messages/educational information that the physician is not needed.
- Falchuk fails to expressly teach in response to said communication (or synchronization) signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device. However, this feature is well known in the art, as evidenced by Wharton.

In particular, Wharton discloses in response to said communication (or synchronization) signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device (Wharton; abstract, col. 2, lines 11-35).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Wharton with the motivation of synchronizing display of data relating to a predetermined application between an

interactive terminal and at least one mobile interface device having a display (Wharton; abstract).

B. Claim 46 is amended now to recite the method of claim 45, wherein said identifying is based on information selected from the group consisting of: a practice area of each of the physicians; a number of prescriptions written by each of said physicians; a Drug Enforcement Agency number of each of said physicians, a medical education number of each of said physicians, and or any combination of the aforementioned (Falchuk; col. 3, lines 47-52 and col. 5, lines 48-54).

- The obviousness of modifying the teaching of Falchuk to include identifying at least two physicians (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

C. Claim 47 is amended now to recite the method of claim 45, wherein said identifying is based on a medical education number of each of said physicians (Falchuk; col. 3, lines 47-52 and col. 5, lines 48-54).

- The obviousness of modifying the teaching of Falchuk to include identifying at least two physicians (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

D. Claim 48 is amended now to recite the method of claim 45, further comprising, after said identifying, examining respective profiles of said identified

physicians, wherein said interactive message is customized based on said respective profiles (Falchuk; col. 6, lines 1-10).

- The obviousness of modifying the teaching of Falchuk to include identifying at least two physicians (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

E. Claim 49 is amended now to recite the method of claim 45, wherein the interactive message includes an interactive question directed to the physicians (Falchuk; col. 5, lines 35-47).

- The obviousness of modifying the teaching of Falchuk to include identifying at least two physicians (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

F. Claim 50 is amended now to recite the method of claim 45, wherein the interactive message includes a question asking the physician if the physicians would like further information on a certain medical topic (Falchuk; col. 5, lines 35-47).

- The obviousness of modifying the teaching of Falchuk to include identifying at least two physicians (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

Art Unit: 3626

G. Claim 51 is amended now to recite the method of claim 45, wherein the interactive message includes an inquiry whether said physicians wishes to receive Continuing Medical Education (CME) (Falchuk; col. 5, lines 48-58).

- The obviousness of modifying the teaching of Falchuk to include identifying at least two physicians (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.
- Also, the obviousness of modifying the teaching of Falchuk to include transmitting said interactive message from the computer system to said respective handheld computing device (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

H. As per claim 52, Falchuk discloses the method of claim 51, wherein the Continuing Medical Education includes educational materials or multiple choice exams (Falchuk; col. 5, lines 48-58).

I. Claim 53 is amended now to recite the method of claim 45, further comprising, after said transmitting, receiving a response from said respective one of said physicians (Falchuk; col. 5, lines 35-47).

- The obviousness of modifying the teaching of Falchuk to include identifying at least two physicians (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

J. As per claim 54, Falchuk discloses the method of claim 53, further comprising, sending further medical information to said physician based on said response (Falchuk; col. 6, lines 10-27).

K. Claim 55 is amended now to recite the method of claim 45, wherein the interactive message includes an inquiry whether said physicians wish to receive Continuing Medical Education (CME) (Falchuk; col. 5, lines 48-58), and said method further comprises, after said transmitting, receiving a response from said respective one of said physicians and transmitting CME educational materials or multiple choice exams to said respective handheld computing device operated by said respective one of said identified physicians if said response indicated that said respective one of said physicians wishes to receive Continuing Medical Education (CME) (Falchuk; col. 5, lines 48-67).

- The obviousness of modifying the teaching of Falchuk to include identifying at least two physicians (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.
- Also, the obviousness of modifying the teaching of Falchuk to include transmitting said interactive message from the computer system to said respective handheld computing device (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

L. As per claim 56, Falchuk discloses the method of claim 45, wherein said generating further comprises associating an expiration date with said interactive message expires after a predetermined time (Falchuk; col. 4, lines 53-61).

M. Claim 57 is amended now to recite the method of claim 45, wherein said generating further comprises associating an expiration date with said interactive message, such that said interactive message expires after a predetermined time and is thereafter removed (Falchuk; col. 4, lines 53-61).

- The obviousness of modifying the teaching of Falchuk to include transmitting said interactive message from the computer system to said respective handheld computing device (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

N. Claim 58 is amended now to recite the method of claim 45, wherein said interactive message is configured to be automatically displayed to said respective one of said identified physicians (Falchuk; col. 6, lines 24-27, lines 28-43) once downloaded to said respective handheld computing device.

- The obviousness of modifying the teaching of Falchuk to include identifying at least two physicians (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.
- Also, the obviousness of modifying the teaching of Falchuk to include transmitting said interactive message from the computer

system to said respective handheld computing device (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

O. Claim 59 is amended now to recite the method of claim 45, wherein said receiving further comprises receiving, from said respective handheld computing device, an amount of interactive messages stored on said respective handheld computing device; and if said amount is above a maximum amount, storing said interactive message on the server instead of transmitting said interactive message to said respective handheld computing device.

- Neither Falchuk nor Wharton explicitly disclose an amount of interactive messages stored on said respective handheld computing device; and if said amount is above a maximum amount, storing said interactive message on the server instead of transmitting said interactive message to said respective handheld computing device. However, the Examiner takes official notice that it was well known in the electronic messaging/computing arts to store interactive messages in the handheld computing device and if the amount of messages is above a maximum amount, store interactive messages on the server. The motivation would have been to maintain the storage capacity for the handheld computing device and not lose any messages.

Art Unit: 3626

P. As per claim 60, Falchuk discloses the method of claim 45, further comprising repeating said generating and transmitting steps for multiple interactive messages (Falchuk; col. 3, lines 27-31).

Q. As per claims 61-62 Falchuk discloses the method of claim 45.

- The obviousness of modifying the teaching of Falchuk to include transmitting said interactive message from the computer system to said respective handheld computing device (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

- In addition, Neither Falchuk nor Wharton explicitly disclose storing a set maximum amount of message at any one time and prioritizing the interactive message by a category selected from the group consisting of: an expiration date, importance and urgency.

However, the Examiner takes official notice that it was well known in the electronic messaging/computing arts to storing a set maximum amount of message at any one time and prioritizing the interactive message by a category selected from the group consisting of: an expiration date, importance and urgency. The motivation would have been to maintain the storage capacity for the handheld computing device and not loose any messages.

R. Claim 63 is amended now to recite the method of claim 45, further comprising:

Art Unit: 3626

- i. Storing medical data in a database (Falchuk; col. 2, lines 38-46, col. 3, line 53-col.4, line 3) on the server; and
- ii. Communicating at least some of said medical data from said database (Falchuk; col. 3, lines 53- col. 4, line 3, col. 5, lines 48-67) to said respective handheld computing device in response to a connection signal received from said respective handheld computing device

- Falchuk fails to expressly teach a server and at the server identifying at least two users from a database of multiple users. However, this feature is well known in the art, as evidenced by Wharton.

In particular, Wharton discloses a server and at the server identifying at least two users from a database of multiple users (Wharton; abstract, col. 2, lines 11-35, col. 3, lines 42-44, col. 3, line 64 to col. 4, line 14).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Wharton with the motivation of allowing multiple mobile interface devices to interact with an interactive terminal (Wharton; col. 2, lines 8-10).

S. As per claim 64, Falchuk discloses the method of claim 63, further comprising, before said storing, aggregating said medical data from multiple sources (Falchuk; col. 2, lines 22-46).

T. Claim 66 has been amended now to recite the method of claim 63, wherein said communicating said medical data further comprises:

i. Receiving a request for medical data (Falchuk; col. 2, lines 11-21) from said respective handheld computing device;

ii. Responding to the request by sending at least a portion of said medical data (Falchuk; col. 2, lines 22-37) to said respective handheld computing device.

- The obviousness of modifying the teaching of Falchuk to include a handheld computing device (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

U. Claim 89 has been amended now to recite the method of claim 48, wherein examining, for each of the identified physicians, count data, said count data recording access time and frequency, and input data, said input data tracking all input for each of identified physicians (Falchuk; col. 5, line 48 to col. 6, lines 10).

- The obviousness of modifying the teaching of Falchuk to include identifying at least two physicians (as taught by Wharton) is as addressed above in the rejection of claim 45 and incorporated herein.

V. Claim 90 has been amended now to recite the method of claim 45, wherein the objects include answers the physicians can select without typing text.

- Falchuk fails to expressly teach objects include answers the physicians can select without typing text. However, this feature is well known in the art, as evidenced by Wharton.

In particular, Wharton discloses objects include answers the physicians can select without typing text (Wharton; col. 3, lines 55-63).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Wharton with the motivation of user interacts with mobile interface device by touching control buttons (Wharton; col. 3, lines 55-63).

13. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Falchuk et al, (hereinafter Falchuk) (U.S. Patent No. 6,256,613), Wharton et al. (hereinafter Wharton) (U.S. Patent No. 5,831,664), Examiner's official notice and further in view of Edelson et al. (hereinafter Edelson) (U.S. Patent No. 5,737,539).

A. As per claim 65, Falchuk discloses the method of claim 64, wherein said aggregating step further comprises collecting

Falchuk fails to expressly teach medical data from a group consisting of: formulary data, pharmacopia data, and any combination of the aforementioned, per se, since it appears that Falchuk is more directed to a medical data consisting of medical journals, tutorials (Falchuk; col. 3, line

53-col. 4, line 3). However, this feature is well known in the art, as evidenced by Edelson.

In particular, Edelson discloses "medical data from a group consisting of: formulary data, pharmacopia data, and any combination of the aforementioned" (Edelson; col.8, lines 11-16).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Edelson with the motivation of permitting enhancement of the quality of prescribing decisions (Edelson; abstract).

Response to Arguments

14. Applicant's arguments with respect to claims 45-66 and 89-90 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach "Synchronization signal generator" 4769704 A, "Interactive medical training system" 5791907 A, "Prescription management system" 5,845,255 A, System for synchronizing shared data between computers 5884325 A, Interactive learning system with pretest 6039575 A, Personalizing hospital intranet web sites 6076166 A, Electronic mail system with advertising 6199106 B1, System for analyzing and/or effecting experimental data from a

remote location 6261103 B1, "System and method for remote education using a memory card" 2001/0016310 A1, Method and system for accessing multimedia data in an interactive format having reporting capabilities 6282404 B1, "System and method for improving compliance of a medical regimen" 6,305,377 B1, "Portable ultrasound imaging system" 5,839,442 A," Method and apparatus for electronically accessing and distributing personal health care information and services in hospitals and homes" 5,867,821 A, "Digital signal organized in self-contained data containers, especially for data transmission to selective call receivers" 5,875,178 A.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Application/Control Number: 09/487,932

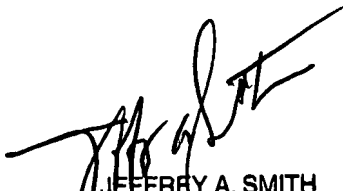
Page 20

Art Unit: 3626

Customer Service Representative or access to the automated information system, call
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Art Unit 3626
08/08/2007


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